

### **REMARKS/ARGUMENTS**

#### Telephone Interview

Applicant appreciates the courtesies extended to Applicant's representative during the November 18, 2008 telephone interview with Examiner Shrestha. Applicant's summary of the substance of the personal interview is contained in the following remarks.

#### Provisional Nonstatutory Double Patenting Rejection

The Office Action provisionally rejects claims 2, 10-13, 20, 22-24, and 28-44 on the grounds of nonstatutory obviousness-type double patenting over various claims of copending Application Nos. 09/981,626; 09/981,645; and 09/981,637. It is noted that the provisional rejection does not require the filing of a terminal disclaimer or response unless and until the claims in one or more of the present and/or cited applications actually issues, or are in condition for allowance, and the provisional rejection is the sole remaining rejection in the Application. Therefore, Applicant will respond to any further non-statutory double patenting rejection when any such rejection is no longer provisional.

#### Rejection Under 35 U.S.C. §103(a)

The Office Action rejects claims 2, 10-13, 20, 22-24 and 28-44 under 35 U.S.C. §103(a) over U.S. Patent No. 7,069,234 to Cornelius *et. al.* (hereinafter "Cornelius") in view of U.S. Patent Application Publication No. 2002/0156656 to Harrell *et. al.* (hereinafter "Harrell"). This rejection is respectfully traversed.

Applicant previously this rejection as applied to claims 2, 10-13, 20 and 22-24 in Applicant's July 2, 2008 Amendment. Those arguments are not repeated herein. The Office Action does not address Applicant's previous arguments regarding the non-obviousness of at least claims 2, 10-13 and 20-24.

As stated in MPEP §2145, consideration of rebuttal evidence and arguments requires office personnel to weigh the proper evidence and arguments. Likewise, as stated in MPEP

§707.07(f), in order to provide a complete Application file history and to enhance the clarity of the prosecution history record, an Examiner must provide clear explanations of all actions taken by the Examiner during prosecution of the Application. Where the Applicant traverses any rejection, the Examiner should, if he or she repeats the rejection, take note of the Applicant's argument and answer the substance of it. At present, Applicant is unsure if these arguments have been considered on their merits, and, if so, where the points of disagreement lie with the Examiner. Therefore, Applicant respectfully requests that the previous arguments, properly submitted in the record, be responded to by the Examiner in a next Office Action.

This matter was discussed with Examiner Shrestha during the November 18, 2008 telephone interview. The Examiner agreed that, upon submission of a formal response, the Examiner would specifically respond to Applicant's argument submitted in the July 2, 2008 Amendment in a next non-final Office Action. Applicant appreciates this agreement by the Examiner.

As such, Applicant understands that the above response is sufficient with respect to the August 6, 2008 Office Action.

Patentable weight of claimed features

In the interest of expediting prosecution of this Application, Applicant also submits the following comments regarding the Examiner's rationale expressed in paragraph 5 of the Office Action.

The Examiner states that "shipping options and terms, and details of cargo insurance are not functionally related to the substrate of the method" and, thus, "this descriptive material would not distinguish the claimed invention from the prior art in terms of patentability." However, this rationale is inapplicable in determining the patentability of the relevant features. For example, the features recited in claims 20, 22 and 23 provide additional features regarding the cargo insurance recited in claim 2.

Claim 2 recites, among other features, means for automatically calculating a cargo insurance premium required to purchase the cargo insurance based upon information electronically stored in the system and comprising at least one of the locations to be shipped

from, a location to be shipped to, a means of shipment, and a party responsible for purchasing of the one or more goods. The features of claims 20, 22 and 23 provide further specificity with respect to the type and extent of the insurance and properly depend from claim 2. Therefore, Applicant submits that the features recited in claims 20, 22 and 23 cannot be disregarded as "not functionally related to the substrate of the method."


### **CONCLUSION**

In view of the foregoing, Applicant believes all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 202-481-9900.

The Commissioner is authorized to charge any fees due or credit any overpayment to the Deposit Account of Townsend and Townsend and Crew LLP, Deposit Account No. 20-1430.

Respectfully submitted,

  
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Attachment:

Petition for Extension of Time

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